

REMARKS

The Applicant does not believe that entry of the foregoing amendment will result in the introduction of new matter into the present application for invention. Therefore, the Applicant, respectfully, requests that the foregoing amendment be entered and the claims to the present invention be, kindly, reconsidered.

The Final Office Action dated March 3, 2004 has been received and considered by the Applicants. Claims 1-20 are pending in the present application for invention. Claims 1-20 stand rejected by the March 3, 2004 Final Office Action.

The Final Office Action rejects Claims 1, 3, 5-6, 12, 14 and 16-17 under the provisions of 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,986,638 issued to Cheng (hereinafter referred to as Cheng) taken with U.S. Patent No. 5,940,076 issued to Sommers et al. (hereinafter referred to as Sommers et al.). The Examiner states that Cheng teaches a method and apparatus for synchronously selecting icons in a flywheel controlled color computer (col. 1, lines 40-49 and Fig. 2). The Examiner further states that Cheng teaches an image control system for controlling a display menu comprising: a menu for display, with the menu being arranged as a plurality of simultaneously displayed menu items in a loop (col. 2, lines 3-11, 36-39 and Fig. 2); a selector to select items from the menu, wherein the selector is movable with respect to the loop (col. 2, lines 48-51); and a flywheel as a user input device for inputting an instruction, wherein the flywheel generates a control signal to move the selector about the loop of menu icons (col. 2, lines 26-31, 48-67 and col. 3, lines 1-11). The Examiner states that Cheng does not teach that the loop is moveable with respect to the selector. The Applicant would like to, respectfully, point out the rejected claims recite that "the loop and the selector being moveable with respect to each other". Cheng teaches a selector that is moveable with respect to the loop taught therein.

The Examiner asserts that Sommers et al. teach a loop and selector device that are moveable relative to each other at col. 4, lines 36-46. The Applicant would like to, respectfully, point out Sommers et al. at col. 4, lines 36-46 teaches a loop the is moveable with respect to the selector. The rejected claims recite "the loop and the selector being moveable with respect to each other". Sommers et al. teach a "wheel" GUI with selectable features that are rotated through a display window 68 (see col. 3, lines 57-

61). Icons contained within the loop of Sommers et al. are rotated into display 68 by pressing an up or down control key. The display 68, within Sommers et al. remains fixed and the only movement occurs within the loop of menu icons. To select one of the menu icons within the loop, that icon must first be placed within the window referred to within Sommers et al. as display 68. Once within the display window 68, it is possible for the user to select one of the menu items by again pressing an up or down key. The Examiner has combined the selection process of Sommers et al. with that of Cheng, which teaches a selection process used in an On Screen Display (OSD) for computer monitors. According to the teachings of Cheng, a flywheel allows the user to move a cursor display that is displayed on the OSD along a circular path containing icons arranged in a circle on the OSD (col. 2, lines 48-67). Cheng does not disclose, or suggest, the loop and the selector being moveable with respect to each other. Moreover, Cheng does not disclose, or suggest, a movement around the loop configuration of the control device that causes a corresponding relative movement between the selector and the loop of the menu. Sommers et al. do not disclose, or suggest the loop and the selector being moveable with respect to each other. Moreover, Sommers et al. do not disclose, or suggest a movement around the loop configuration of the control device that causes a corresponding relative movement between the selector and the loop of the menu. Therefore, there remain recited elements within the rejected claims that are not found in the combination made by the Final Office Action.

The MPEP at §2143.03 states that in order to "establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). As previously discussed, neither cited reference, Sommers et al. or Cheng, teach the loop and the selector being moveable with respect to each other. Moreover, neither cited reference, Sommers et al. or Cheng, teach the movement around the loop configuration of the control device that causes a corresponding relative movement between the selector and the loop of the menu.

The Applicant, respectfully, points out that there must exist the requisite suggestion, or motivation, within the cited references, Sommers et al. and Cheng, to modify the combination made by the Final Office Action and arrive at the invention recited by the rejected claims. The MPEP at §2143 states that although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). The Applicant would like to, respectfully, point out that the Final Office Action has not provided any suggestion or motivation within either Sommers et al. or Cheng, to modify the combination made by the Final Office Action and arrive at the invention recited by the rejected claims. The only motivation supplied by the Final Office Action is to provide the feature of rotating the loop simultaneously with the selector in order to expand the number of applications that may be selected, which motivation is not given by any of the cited references. This Applicant, respectfully, asserts that this motivation is nothing more than employing the elements of the rejected claims as a template from which to pick and choose the recited elements from prior art references. The court indicated in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), that it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious. More to the point, the mere fact that some prior art reference may be modified in the manner suggested by the Examiner does not make such a modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, the prior art relied upon by the Examiner contains no such suggestion. Accordingly, this rejection is respectfully traversed.

The Final Office Action rejects Claims 2, 7-8, 13 and 18 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Cheng taken with Sommers et al., as applied to Claim 1, and further in view of U.S. Patent No. 5,667,319 issued to Satloff (hereinafter referred to as Satloff). The Examiner states that Satloff teaches an image control system wherein the input device comprises at least one force sensing resistor or a joystick at col. 7, lines 29-36. The Applicants, respectfully, submit that Claims 2 and 13 must be viewed in conjunction with the claims from which they depend,

wherein movement around the loop configuration of the control device creates the similar movement around the display loop. Satloff relates to keyboards, and the paragraph cited by the Examiner on col. 7, lines 29-36, does not disclose, or suggest, a movement around a loop configuration of the control device that causes a corresponding relative movement between a selector and a loop of a menu. Moreover, there is no motivation provided by any of Cheng, Sommers et al., or Satloff to modify the teachings contained therein to create a movement around a loop configuration of the control device that causes a corresponding relative movement between a selector and a loop of a menu. Accordingly, this rejection is respectfully traversed.

Regarding, Claim 7, the Applicant, respectfully, submits that teachings of a joystick within Satloff alone does not suggest the rejected elements of Claim 7. There is no motivation provided by any of Cheng, Sommers et al., or Satloff to modify the teachings contained therein to create a movement around a loop configuration of a joystick that causes a corresponding relative movement between a selector and a loop of a menu. Accordingly, this rejection is respectfully traversed. Regarding Claims 8 and 18, there is no suggestion by any of Cheng, Sommers et al., or Satloff of a force-sensing resistor being used within a joystick to receive a force from a user and create a movement around a loop configuration of a joystick that causes a corresponding relative movement between a selector and a loop of a menu. Accordingly, this rejection is respectfully traversed.

The Final Office Action rejects Claim 4, 15 and 20 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Cheng taken with Sommers et al., as applied to Claim 1, and further in view of U.S. Patent No. 4,736,191 issued to Matzke, et al. (hereinafter referred to as Matzke et al.). Regarding Claim 4, the Applicant would like to, respectfully, point out that Matzke et al. do not disclose, or suggest, an annular pressure pad to receive pressure from a user and generate the control signal corresponding to the angular position on the pressure pad at which pressure is applied wherein the loop and the selector being moveable with respect to each other. Moreover, Matzke et al. do not disclose, or suggest, a movement around the loop configuration of an annular pressure pad that causes a corresponding relative movement between the selector and the loop of the menu. Regarding Claim 15, there is no suggestion within the cited

reference Matzke et al., to control the loop display position by applying pressure on the pressure pad to create a corresponding movement in the loop and the selector relative to each other as recited by rejected Claim 15. Regarding Claim 20, there is no suggestion within the cited reference Matzke et al., for a continuous circular movement upon an annular control device causing a corresponding relative movement between the selector and the loop of the menu in a series of discrete steps. The Applicant respectfully submits that the loop and selector moving in discrete steps is different than a continuous movement of the loop and the selector. In a digital world, everything is computed in discrete steps. However, the display can take the form wherein the movement of the loop and the selector appears continuous to the user or the display can take form wherein the movement of the loop and the selector appears to occur in discrete steps. The Applicant asserts that neither the display wherein the movement of the loop and the selector appears continuous to the user or the display wherein the movement of the loop and the selector appears to occur in discrete steps is disclosed, or suggested, by the combination made by the Final Office Action. Accordingly, this rejection is respectfully traversed.

The Final Office Action rejects Claim 9 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Cheng taken with Sommers et al., as applied to Claim 1, and further in view of U.S. Patent No. 6,501,516 issued to Clapper (hereinafter referred to as Clapper). Cheng relates to an on screen display (OSD) for computer monitors. Sommers et al. relates to Graphical User Interfaces. The Applicant, respectfully, submits that the Final Office Action has not provided any motivation for employing the teachings of these several references to televisions and remote controls for televisions. The Applicant, respectfully, asserts that the Examiner is using the elements to the rejected claims of the present invention as a template to pick and choose the recited elements of the rejected claims from among various prior art references. There is no suggestion or motivation within the cited reference to combine the set of references combined by this rejection. Accordingly, this rejection is respectfully traversed.

The Final Office Action rejects Claim 10 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Cheng taken with Sommers et al., as applied to Claim 1, and further in view of U.S. Patent No. 5,736,703 issued to Kim (hereinafter referred to as Kim). The Applicant would like to, respectfully, point out that Kim employs a rotary device to scroll

through a function list. There is no disclosure, or suggestion, within Kim for using the rotary device for controlling the simultaneous movement of both a loop and a selector wherein movement around the rotary device causes a corresponding relative movement between the selector and the loop of the menu. The Applicants, respectfully assert that the Examiner is picking and choosing among prior art references using the elements to the rejected claims of the present invention as a blueprint. There is no suggestion to combine the set of references combined by this rejection. Accordingly, this rejection is respectfully traversed.

The Final Office Action rejects Claims 11 and 19 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Cheng taken with Sommers et al., as applied to Claim 1, and further in view of U.S. Patent No. 6,405,061 issued to Bae (hereinafter referred to as Bae). The Applicant would like to respectfully point out that Bae discloses a touch pad but there is no disclosure of an annular pressure pad to receive pressure from a user and generate the control signal corresponding to the angular position on the pressure pad at which pressure is applied. Accordingly, the recited elements of Claim 11 and 19 are completely omitted in this rejection. There is no suggestion to combine the set of references combined by this rejection. Accordingly, this rejection is respectfully traversed.

Applicant is not aware of any additional patents, publications, or other information not previously submitted to the Patent and Trademark Office which would be required under 37 C.F.R. 1.99.

In view of the foregoing amendment and remarks, the Applicant believes that the present application is in condition for allowance, with such allowance being, respectfully, requested.

Respectfully submitted,

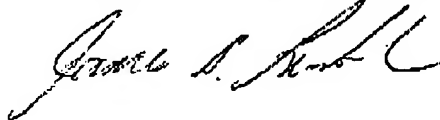
By 

James D. Leimbach, Reg. 34,374
Patent Attorney (585) 381-9983

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence
is being transmitted on this date via
facsimile transmission to (703) 872-9306 AND addressed to:
COMMISSIONER OF PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Date of Transmission: April 14, 2004



(Signature)